

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HYUN-SOO LEE

Appeal No. 1998-0701
Application 08/263,744

ON BRIEF

Before JERRY SMITH, FLEMING AND FRAHM, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-13, which constitute all the claims in the application.

The disclosed invention pertains to the field of recording and reproducing audio and video signals. More particularly, audio and video information is recorded along with a record mode discrimination signal which has a predetermined frequency and a periodicity within the signal that is dependent upon the record mode. The recorded discrimination signal can be detected during search mode to control the speed of reproduction during the search mode.

Representative claim 1 is reproduced as follows:

1. In a magnetic recording and reproducing system of the type which records an analog audio and video signal on a recording medium at selected record mode speeds, and which reads out recorded signals from said recording medium, said system having also a read and write head, the improvement comprising:

means for generating a record mode discrimination signal having a predetermined frequency and a periodicity within the signal that is dependent upon said record mode,

mixer means for mixing said record mode discrimination signal with said audio and video signal and a pilot signal to provide a mixed signal and for applying said mixed signal to said read and write head for recording on said recording medium,

whereby the recording of said record mode discrimination signal along with said audio and video signal enables the detection of the record mode for said recorded signal.

The examiner relies on the following references:

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Enoki	4,991,027	Feb. 05, 1991
Kim et al. (Kim)	5,319,499	June 07, 1994 (filed Aug. 28, 1991)
Fukami et al. (Fukami)	5,477,396	Dec. 19, 1995 (effectively filed Nov. 26, 1990)
Minoda et al. (Minoda)	5,521,766	May 28, 1996 (effectively filed Apr. 02, 1992)

The following rejections are set forth in the
examiner's answer:

1. Claims 1-13 stand rejected under 35 U.S.C. § 112,
first paragraph, as containing subject matter which was not
described in the originally filed specification.

2. Claims 1-4, 10 and 12 stand rejected under 35
U.S.C.
§ 103 as being unpatentable over the teachings of Fukami and
Minoda.

3. Claims 5-7 and 13 stand rejected under 35 U.S.C.
§ 103 as being unpatentable over the teachings of Fukami,
Minoda and Enoki.

4. Claims 8, 9 and 11 stand rejected under 35 U.S.C.

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§ 103 as being unpatentable over the teachings of Fukami, Minoda, Enoki and Kim.

Rather than repeat the arguments of appellant or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the obviousness rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the originally filed specification supports the invention now being claimed as required by 35 U.S.C. § 112. We are also of the view that the evidence relied upon and the level of skill in the particular art would not have

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suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-13. Accordingly, we reverse.

Appellant has indicated that for purposes of this appeal the claims within each rejection will stand or fall together as a single group [brief, page 5]. Consistent with this indication appellant has made no separate arguments with respect to any of the claims subject to the same rejection. Accordingly, all the

claims within each rejection will stand or fall together.

Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

We consider first the rejection of claims 1-13 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the originally filed specification. The rejection results from a finding by the examiner that an amendment to independent claims 1 and 10 was new matter which was unsupported by the original disclosure. The amendment in question amended the phrase "records an audio and video signal" in claims 1 and 10 to "records an analog audio and

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video signal." The original disclosure describes the invention as being useful in a conventional 8mm camcorder. The examiner's rejection is based on the position that the person of ordinary skill in the art would not have recognized that an 8mm camcorder operated on audio and video signals which were both analog.

Appellant's argument that the first paragraph of 35 U.S.C. § 112 is not an appropriate basis for asserting that amendments to the claims are not supported by the original disclosure is without merit. A rejection of claims which supposedly contain new matter, or material which is unsupported by the original disclosure, is a rejection based on the written description requirement of 35 U.S.C. § 112. Therefore, the examiner's rejection is clearly made under the proper statutory authority.

Notwithstanding appellant's assertion that the rejection is made under the wrong statutory basis, appellant also makes the argument that the person skilled in this art would have understood that conventional 8mm camcorders recorded signals in analog form. Additionally, appellant argues that the original disclosure is generic to analog and

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digital signals and that appellant is not precluded from limiting the claimed invention to analog signals only.

The purpose of the written description requirement is to ensure that the applicant conveys with reasonable clarity to those skilled in the art that he was in possession of the invention as of the filing date of the application. For the purposes of the written description requirement, the invention is "whatever is now claimed." Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1564, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Thus, the critical question on this issue is whether appellant was in possession of the magnetic recording and reproducing system with respect to analog audio and video signals at the time this application was filed.

We decide this question in favor of appellant for essentially the reasons argued by appellant in the brief. We are not persuaded by the examiner's view that the original disclosure only supports recording and reproducing digital audio data and that the phrase "analog audio and video signal" constitutes new matter. The original disclosure relates to a conventional 8mm camcorder. The evidence on this record

supports appellant's position that conventional 8mm camcorders were known to operate on analog audio and video signals. The examiner's position could only be tenable if the examiner had demonstrated that only digital recording and reproduction of signals was known from conventional 8mm camcorders. The present record does not support this position of the examiner.

Therefore, we find that the original disclosure provides written description support for the phrase "an analog audio and video signal" as recited in independent claims 1 and 10. Thus, we do not sustain the examiner's rejection of the claims as being based on an inadequate disclosure.

We now consider the various prior art rejections. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill

in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d

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1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

With respect to the rejection of claims 1-4, 10 and 12, we consider independent claim 1 as the representative claim for this group. The examiner essentially finds that Fukami teaches all the features of claim 1 except for the recording and reproducing of video signals. The examiner cites Minoda as teaching that it was conventional to record both audio and video signals on the same magnetic tape. The examiner concludes that it would have been obvious to the artisan to record video data on Fukami's tape as taught by Minoda [answer, page 4].

Appellant argues that Fukami relates to digital audio recording and reproduction only. He also argues that the status byte of Fukami, which indicates tape speed, does not constitute a discrimination signal having a predetermined frequency and a periodicity within the signal that is

dependent on the record mode as recited in claim 1 [brief, pages 10-11]. Finally, appellant argues that there would be no motivation to combine Minoda's video signals with the digital audio tape of Fukami [id., pages 12-13].

The examiner's initial response to appellant's argument that Fukami is not directed to analog audio and video data is to note that this claim limitation is new matter [answer, page 10]. This response is inappropriate because limitations of a claim cannot be ignored when making prior art rejections even if the claim limitations are unsupported by the disclosure. The examiner additionally attempts to find that the control data of Fukami meets the recitation of frequency and periodicity as recited in claim 1. We agree with appellant, however, that the byte of control data of Fukami does not meet the claim limitations for reasons explained on pages 10-11 of the brief.

Since we agree with appellant that the means for generating a record mode discrimination signal as recited in claim 1 is not taught or suggested by the collective teachings of Fukami and Minoda, the examiner has failed to establish a prima facie case of obviousness. Therefore, we do not sustain

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the rejection of claims 1-4, 10 and 12 based on these teachings.

The rejection of claims 5-9, 11 and 13 relies on the same combination of Fukami and Minoda discussed above. Since the additional teachings of Enoki or Enoki and Kim do not overcome the deficiencies in the basic combination discussed above, we do not sustain the rejection of these claims based on the prior art cited by the examiner.

In summary, we have not sustained any of the examiner's rejections of the claims. Therefore, the decision of the examiner rejecting claims 1-13 is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
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MICHAEL R. FLEMING)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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ERIC FRAHM)
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